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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,256	01/18/2001	Trevor Smith	BSE 301	8276

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EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 08/01/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/766,256

Applicant(s)

SMITH, TREVOR

Examiner

Kurt Fernstrom

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,5-7,13,20,21,25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-7,13,20,21,25 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 3712

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 26 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The subject matter of claim 26 has been incorporated into claim 25, from which claim 26 depends.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a generalized method of creating a program, and contain numerous examples of method steps which are taken by various third parties, including the managing board, the sponsors, and the students. Method claims which include steps which are intended to be performed by various entities are not patentable. Also, the invention is not within the technological arts.

Art Unit: 3712

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1, 5-7, 13, 20, 21, 25 and 26 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Numerous method steps described in the aforementioned claims, including production of a television show, production of a magazine, production of a computer-network based program, “training volunteers to coach students” and “applying inventive skills to develop new products” are not adequately described in the specification so as to enable one skilled in the relevant art to perform the method. In particular, the production of a computer program of claims 6, 13 and 25 does not appear to be disclosed in the specification at all. Rather, the use of a computer-network based program is disclosed.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1, 5-7, 13, 20, 21, 25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

Art Unit: 3712

applicant regards as the invention. The claims are replete with terminology whose scope is unclear, rendering the claims indefinite. While the instances of indefinite language are too numerous to list each one, the following examples are provided as a guide to assist the applicant in preparing a response. The phrases “coordination of acquiring funds,” “encouraging the students in connection with the activity to purchase goods or services,” “recruiting a plurality of volunteers,” “training the volunteers,” “intellectual activity,” “apply inventive thinking skills in a business setting to develop new products” are all vague and indefinite and do not define the scope of the claims. For example, what concrete method step is defined by “encouraging” or “training” someone to do something? What is considered to be “inventive thinking skills”?

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 13, 20, 21 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carmarthenshire Youth & Children’s Association (“CYCA”) in view of SJ Barons Pro Soccer (“Barons”), and further in view of HIV/AIDS Ministries Network - Focus Paper #28 (“HIV/AIDS”). It is well known to provide a board to manage a program including a youth club which provides various physical and intellectual activities to youth. CYCA discloses on such

Art Unit: 3712

example of a youth club founded in 1981, which is managed by a board of trustees. Boards of trustees inherently perform such tasks as fund raising and management and recruitment and training of volunteers. Each of these steps is disclosed by CYCA. CYCA fails to disclose that the funding includes a sponsor which gives discounts to members of the group. It is well known that various clubs are commonly sponsored by business organizations. Barons discloses one such example, in the "Affiliated Club Programs" section, of a business organization which sponsors affiliated clubs and provides tickets to sporting events and other discounts to various services. FA further sponsor relationship is disclosed whereby uniforms can be purchased at a discount through the sponsor, where said purchase is inherently encouraged through the discount. While the step of donating a portion of sales revenues to the club is not explicitly disclosed, Official Notice is taken that it is common for business organizations to donate a portion of sales revenues to one or more charitable organizations. It would have been obvious to modify the method disclosed by CYCA by providing a sponsor which offers goods at a discount to club members and donates a portion of sales to the club for the purpose of providing an additional revenue source to the club. Applicant has further acknowledged on page 8 line 10 to page 9, line 7 of the specification that it is known to provide a program of providing mentors to student inventors to aid them in developing new products, as claimed in claims 20 and 21. It would have been obvious to modify the method disclosed by CYCA as viewed in combination with Barons by providing mentors to guide students in developing new products for the purpose of instructing students how to develop a product in a business setting. CYCA and Barons fail to disclose the production of a television

Art Unit: 3712

show. HIV/AIDS discloses on page 5 a method of providing AIDS education to teens comprising the step of producing a television show. It would have been obvious to modify the method disclosed by CYCA as viewed in combination with Barons by providing the step of producing a television show for the purpose of allowing members to learn the various tasks associated with production of a television show, and for the purpose of learning about various subjects in a creative environment.

10. Claims 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over CYCA in view of Barons, and further in view of Youth Communications. CYCA as viewed in combination with Barons discloses all of the limitations of claim 5 with the exception of the production of a magazine. Magazines produced by youth groups are well known. Youth Communications discloses two examples of magazines produced by youth groups. It would have been obvious to modify the method disclosed by CYCA as viewed in combination with Barons by providing the step of producing a magazine for the purpose of allowing members to learn the various tasks associated with production of a magazine, and for the purpose of communicating ideas to a larger group of people. CYCA as viewed in combination with Barons discloses all of the limitations of claim 7 with the exception of the board of advisers. Boards of advisers are a well known feature of various organizations. Youth Communications discloses on page 3 a program comprising a board of advisers, where the members have expertise in various areas such as magazine production and community relations. It would have been obvious to modify the method disclosed

Art Unit: 3712

by CYCA as viewed in combination with Barons by providing a board of advisers for the purpose of providing advice given by people who have expertise in various areas.

11. Claim 6 is are rejected under 35 U.S.C. 103(a) as being unpatentable over CYCA in view of Barons, and further in view of The Militant. CYCA as viewed in combination with Barons discloses all of the limitations of claims 6, 15 and 26 with the exception of the production of a computer program. The Militant discloses in paragraph 2 of page 1 a method of managing a youth club comprising the step of producing a computer-network based program. It would have been obvious to modify the method disclosed by CYCA as viewed in combination with Barons by providing the step of producing a computer program for the purpose of allowing members of various affiliated clubs to share information over a network.



Serial Number: 09/766,256

Art Unit: 3712

Page 6

***Response to Arguments***

12. Applicant's arguments filed on February 21, 2003 have been fully considered but they are not persuasive.

13. With respect to the rejections made under 35 USC 101, it is true that the claimed method is a "process", within the broad meaning of the term. However, not all processes comprise patentable subject matter. Under 35 USC 101, statutory subject matter is defined as "any new and useful process, machine, manufacture or composition of matter". To be useful, a process must be directed to a practical application in the technological arts. Here, no technology is claimed as part of the invention. As a result, the claimed process is abstract, and is not patentable subject matter. See *Ex parte Bowman*, 61 USPQ2d 1669 (Unpublished). Also, there is no physical transformation of matter from a first state to a second state as a result of the process, thus also rendering the process non-statutory. See *Diamond v Diehr*, 450 U.S. 175, 209 USPQ 1 (1981). In short, a generalized teaching and organization method as claimed in claim 1 does not constitute a patentable process within the scope of 35 USC 101.

14. With respect to the rejections made under 35 USC 112, first and paragraph, the amendments to the claims do not render the rejections moot. Many of the terms which caused the claims to be rejected remain in the claims, as discussed above.

15. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

Serial Number: 09/766,256

Art Unit: 3712

suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references cited are all analogous, in that each discloses a method for providing various educational programs to youth groups. Particularly in an area such as youth groups, which comprise wide varieties of activities, one of ordinary skill in the art would know to combine the programs of several groups when forming a new group, using the knowledge generally available, to provide youth with a wide variety of educational opportunities. Also, the advantages of providing the programs of Youth Communications and The Militant are disclosed in each of those references. While none of the individual references disclose or suggest a method having all of the limitations of the claims; that is not the proper test for determining patentability.

16. Because new grounds of rejection have been presented, in particular concerning 35 USC 101, this Office Action is made non-final.

### Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

July 30, 2003

Kurt Fernstrom  
Kurt Fernstrom